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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/767,044
Filing Date: January 29, 2004
Appellant(s): HINTERMEISTER ET AL.

Grant A. Johnson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/01/2010 appealing from the Office action mailed 12/30/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,461,168	WAN	12-2008
2005/0185055 A1	MILLER et al.	08-2005
2002/0089549 A1	MUNRO et al.	07-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 30-32 and 34, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 USC 112, second paragraph. See MPEP 2173.05(p). Since it is not clear whether the Appellant is intending to claim a computer program product or a method, the claim is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-32 and 34 are rejected under 35 U.S.C. 101 because they are directed to nonstatutory subject matter.

Claims 30-32 and 34 recite “computer-readable storage media” which has been defined by Applicant on page 11 of the Specification as “signal bearing media” which includes carrier waves and signals. See lines 18-26 which recites, “Examples of signal bearing media include. . .alterable information stored on writable storage media”. Therefore, claims 30-34 are not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to make them statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-25, and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Wan, US 7,461,168 B1, 12/02/08 (filed 09/15/00).

Regarding claim 22, Wan discloses a method for displaying information online such as through a web page which meets the preamble.

Wan discloses ***receiving a multi-image file via a network interface, wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display.*** See figures 12-13, the <ImageGroup id> which is the multi-image file which is a single data file and <image href> tags which identify the primary and secondary images. Wan discloses the primary and secondary images can be different versions of an image such as of a rocket before it is launched and while it is launching. See figure 13.

Wan discloses ***receiving a web page containing a markup language tag via the network interface, the markup language tag comprising code specifying a first subset of the images in the multi-image file that should be displayed.*** See figures 12-13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where markup language tags indicates which image of the multi-image file should be displayed or which "fragment" of a resource should be displayed using the <ImageGroupID> and <image href> markup language tags.

Wan discloses ***selectively displaying only the specified subset of images from the multi-image file on a display unit.*** See figure 13, column 1, lines 20-34 and columns 17-19 which discuss rendering a web page. See figures 12-13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where markup language tags indicates which image of the multi-image file should be displayed or which "fragment" of a resource should be displayed using the <ImageGroupID> and <image href> markup language tags.

Regarding claim 23, Wan discloses ***an information header containing an image name for each image in the multi-image file*** as in figure 13. See the <ImageGroupId='RocketImages'> and <Imagehref='#BeforeLaunch'>.

Regarding claim 24, Wan discloses the information header comprises a ***primary image indicator.*** See figure 13 where the primary image is the first image, <Imagehref='#BeforeLaunch'>.

Regarding claim 25, Wan discloses *the information header further comprises an image location in the multi-image file for each image*. See figure 13 where for each image group, the location of the file is identified by <Image href>.

Regarding claim 29, Wan discloses the markup language tag can be in XML or HTML. See column 1, lines 64-67 through column 2, lines 1-6.

Regarding claim 30, Wan discloses a method for displaying information online such as through a web page which meets the preamble.

Wan discloses *receiving a multi-image file via a network interface, the multi-image file consists of a single data file comprising a plurality of independent images including a primary image and at least one secondary image*. See figures 12-13, the <ImageGroup id> which is the multi-image file which is a single data file and <image href> tags which identify the primary and secondary images. Wan discloses the primary and secondary images can be different versions of an image such as of a rocket before it is launched and while it is launching. See figure 13.

Wan discloses *selecting a first subset of the images in the multi-image file for display*. See figures 12-13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where the code indicates which images of the multi-image file should be displayed or which "fragment" of a resource should be displayed. See figures 12-13, the <ImageGroup id> which is the multi-image file which is a single data file and <image href> tags which identify the primary and secondary images. Wan discloses the

primary and secondary images can be different versions of an image such as of a rocket before it is launched and while it is launching. See figure 13.

Wan discloses ***displaying the selected images on a display unit***. See figure 13, column 1, lines 20-34 and columns 17-20 which discuss rendering fragment of content.

Regarding claim 31, Wan teaches a **web browser** renders images as in column 1, lines 20-34 and column 17, lines 30-67.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan, US 7,461,168 B1, 12/02/08 (filed 09/15/00) in view of Miller et al., US 2005/0185055 A1, 08/25/05 (filed 12/08/00).

In reference to claims 26-27, Wan does not teach in response to an event displaying the web page with a secondary image wherein the event is a mouse-over

event; however, Miller does. Miller teaches user instructions are also displayed, to tell the user to click on the "nicest looking" small picture, which then appears in the preferred image window. The user uses a standard input device, such as the **mouse**, to make this selection in block. For example, if the user preferred the appearance of the image with lower than normal contrast, the user would click on image. In response, the CPU would update the display on the display monitor so that the image displayed in preferred image window had lower than normal contrast, matching the contrast of the selected image, and move the indicator to surround image. At this point, the user can select a different image from among images, in order to display images with other appearances as large images in the preferred image window, or the user can select the "done" icon. See page 4, paragraph [0036]. This meets the limitation, ***in response to an event displaying the web page with a second subset of the plurality of secondary images wherein the event is a mouse-over event.*** It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate a mouse-over event for displaying the web page with a secondary image, as taught by Miller, within the system of Wan as a means for displaying a second image because it enables interactive functions to be used by the user allowing them to carry out image manipulations. See page 4, paragraph [0036].

Claims 28, 32, and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wan, US 7,461,168 B1, 12/02/08 (filed 09/15/00) in view of Munro et al., US 2002/0089549 A1, July 11, 2002.

Regarding claim 28, Wan does not teach the plurality of independent images comprise a menu element.

Munro teaches storing multiple images in a single image file. The multiple images can make up a composition of thumbnail type images for simultaneous display in a browser window. See page 1, paragraph [0008]. The bitmap image has a hierachal system of folders associated with the bitmap image. See page 1, paragraph [0009]. This meets the limitation, **the plurality of independent images comprises a menu item.**

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have substituted the images of Wan to include images comprising menu items as suggested by Munro because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable.

Regarding claim 32, Wan does not discloses the primary and secondary image comprise complementary layers.

Munro teaches the images can be placed in separate layers; the upper layer will overlay the lower one when there is an overlap which meets the limitation ***the primary image and the secondary image comprise complementary layers.*** See page 4-5, paragraph [0044].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Wan's system to include complementary layers as suggested by Munro because both systems deal with visual content and displaying

multiple images from a single file and it would have been obvious to a person of ordinary skill in the art to try displaying images as complementary layers with a reasonable expectation of success since it was known in the art.

Regarding claim 34, Wan does not teach the secondary image overlays the primary image.

Munro teaches the images can be placed in separate layers; the upper layer will overlay the lower one when there is an overlap which meets the limitation, ***wherein at least one secondary image overlays the primary image.*** See page 4-5, paragraph [0044].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Wan's system to include complementary layers as suggested by Munro because both systems deal with visual content and displaying multiple images from a single file and it would have been obvious to a person of ordinary skill in the art to try displaying images as complementary layers with a reasonable expectation of success since it was known in the art.

Regarding claim 35, Wan discloses a method for displaying information online such as through a web page which meets the preamble.

Wan discloses ***receiving a multi-image file via a network interface, wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display.*** See figures 12-

13, the <ImageGroup id> which is the multi-image file which is a single data file and <image href> tags which identify the primary and secondary images. Wan discloses the primary and secondary images can be different versions of an image such as of a rocket before it is launched and while it is launching. See figure 13.

Wan discloses ***identifying a first markup language tag specifying the multi-image file, the first markup language tag comprising code identifying the multi-image file and one or more second codes specifying images in the multi-image file for display.*** See figure 13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where the code includes a tag for the image file (i.e. <ImageGroup id>) and the images in the file <image href>.

Wan discloses ***parsing the multi-image file to identify the one or more images specified by the second codes.*** See figure 13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where a fragment identifier specifies which image to display.

Wan discloses ***simultaneously displaying the one or more images specified by the second code.*** See the code in figure 13 where an image is identified.

Wan does not disclose detecting user interaction with a displayed image.

Munro discloses ***detecting user interaction with a displayed image.*** See page 4, paragraph [0044] where a user can click on an image causing the browser to go to a new location.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Wan's system with Munro's system for displaying multiple

images including detecting user interaction with a displayed image because both Wan and Munro are drawn to displaying multiple images, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Wan further teaches ***identifying a second markup language tag specifying the multi-image file, the second markup language tag comprising the first code and one or more third codes specifying a second subset of images in the multi-image file; parsing the multi-image file to identify one or more images specified by the third codes; and simultaneously displaying one or more images specified by the third codes on the display unit***. See figure 13 where a first code (i.e. <ImageGroup id>) with one or more third codes (<image href='#Launching'>) specifying images in the multi-image file.

Regarding claim 36, Wan does not disclose the primary and secondary image comprise complementary layers.

Munro teaches the images can be placed in separate layers; the upper layer will overlay the lower one when there is an overlap which meets the limitation ***the primary image and the secondary image comprise complementary layers***. See page 4-5, paragraph [0044].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Wan's system to include complementary layers as suggested by Munro because both systems deal with visual content and displaying multiple images from a single file and it would have been obvious to a person of ordinary skill in the art to try displaying images as complementary layers with a reasonable expectation of success since it was known in the art.

Regarding claim 37, Wan does not teach the first set of images overlays a second set of images.

Munro teaches the images can be placed in separate layers; the upper layer will overlay the lower one when there is an overlap which meets the limitation, ***a first set of images. . . overlaying a second set of images.*** See page 4-5, paragraph [0044].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Wan's system to include complementary layers as suggested by Munro because both systems deal with visual content and displaying multiple images from a single file and it would have been obvious to a person of ordinary skill in the art to try displaying images as complementary layers with a reasonable expectation of success since it was known in the art.

Regarding claim 38, Wan discloses the **multi-image file comprises an image descriptor for each of the plurality of images.** See figure 13 where each image has

an image descriptor, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20.

Regarding claim 39, Wan discloses *parsing the multi-image file to identify the one or more images specified by the second codes comprises comparing the second codes to the image descriptors.* See figure 13, column 2, lines 39-67, column 17, lines 25-30 and column 18, lines 1-20 where a fragment identifier specifies which image to display.

Regarding claim 40, Wan does not expressly teach receiving an image file and detecting whether it is a conventional file and displaying the web page with the single image; however, Munro teaches *receiving an image file and detecting whether it is a conventional file and displaying the web page with the single image.* See pages 2-4.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Wan's system with Munro's system for displaying multiple images including detecting user interaction with a displayed image because both Wan and Munro are drawn to displaying multiple images, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 41, Munro further teaches parsing a file for image descriptors.

See paragraph [0029]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Wan's system with Munro's system for displaying multiple images including detecting user interaction with a displayed image because both Wan and Munro are drawn to displaying multiple images, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 42, Wan discloses multi-image file comprises a *primary image specification*. See figure 13 where the primary image is the first image,
<Imagehref='#BeforeLaunch'>.

Regarding claim 43, Wan discloses displaying a primary image. While Wan does not expressly state displaying the primary image upon failure to identify an image specified by one or more second codes, it would have been obvious to a person of ordinary skill in the art at the time of the invention to display the image for which the code is recognized.

(10) Response to Argument

I. Rejections under Section 112

On page 9 of the Brief, Appellant argues the rejections under 35 USC 112. Specifically, Appellant states claims 30-32 and 34 are not ambiguous and are a standard Beauregard claim.

Examiner disagrees.

Regarding claims 30-32 and 34, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 USC 112, second paragraph. See MPEP 2173.05(p). Since it is not clear whether the Appellant is intending to claim a computer program product or a method, the claims are ambiguous and indefinite.

II. Rejections under section 101

On pages 9-10, Appellant argues the rejections under 35 USC 101 for claims 30-32 and 34 should be withdrawn because the Specification at page 11 states the invention is capable of being distributed as a program product on a variety of “signal bearing media” which includes (i)“non-writable storage media”, (ii) “writable storage media” or (iii) “communications medium”. Appellant argues the storage media is a

subset of signal bearing media and thus waves and signals cannot be ascribed to “storage media”.

Examiner disagrees.

Claims 30-32 and 34 recite “computer-readable storage media” which has been defined by Applicant on page 11 of the Specification as “signal bearing media” which includes carrier waves and signals. See lines 18-26 which recites, **“Examples of signal bearing media include. . .alterable information stored on writable storage media”**. Therefore, claims 30-34 are not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

III. Rejections under Section 102 and 103.

On pages 10-16, Appellant argues the rejections under 35 USC 102 and 35 USC 103.

A. Claims 22-32 and 34-43: None of the references teach or suggest “a multi-image. . .wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display”.

On pages 11-12, Appellant provides an overview of the current invention. It is respectfully noted that several of the features discussed on pages 11-12 have not been claimed.

On pages 13-15, Appellant addresses each of the references individually. Examiner will begin with Appellant's arguments directed at the Wan reference on page 15.

Wan

On page 15, Appellant argues Wan fails to teach a multi-image. . .wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display. Specifically, Appellant states Wan is directed at downloading a single file and not a multi-image file wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display. Appellant traverses Examiner's citation of Wan, figures 12-13 stating that figures 12-13 just identifies a particular segment for download and the user must download the entire A/V file. Appellant also states in figure 13, the user only needs to download the desired portion. Appellant states Wan downloads a single A/V file or segment.

Examiner disagrees.

The claim recites, "receiving a multi-image file. . .wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display". Wan discloses receiving **a single data file**

(i.e. identified by the <ImageGroup id>) comprising **multiple images** such as images related to a Rocket Launch including a BeforeLaunch image and a Launching image. Thus, Wan discloses a “multi-image file consisting of a single data file comprising a primary image and a secondary image adapted for cooperative display”. Wan’s file for download such as the ImageGroup “RocketImages” is a single file comprised of multiple images such as a BeforeLaunch image and a Launching image. Thus, Wan clearly teaches a multi-image file consists of a single data file that has multiple images. While Appellant refers to the <ImageGroupID> as a segment, it is noted that the ImageGroup is actually a single file comprised of multiple images.

Munro

On pages 13-14, Appellant argues that Munro describes a browser plug-in that displays multiple bitmap images. Appellant states Examiner relies on paragraph [0008] as teaching the claimed multi-image files. Appellant argues the cited section describes a single image file that is rendered as a mosaic of multiple pictures, not a single file containing multiple images. Appellant further argues Munro merely teaches a server can transcode an image into multiple resolutions

Examiner has withdrawn the rejections under 35 USC 103 over Munro in view of Wan. However, the rejections under 35 USC 103 over Wan in view of Munro have been maintained. Since the features relied upon in the rejections under 35 USC 103 over Wan in view of Munro rely on Munro for teaching “detecting user interaction with a

displayed image”, Appellant’s arguments with respect to whether Munro teaches a multi-file image are moot since Munro is not relied upon to teach this feature.

Miller

On page 14, Appellant argues Miller fails to teach these elements. Miller is relied upon to teach other features that are not argued by the Appellant.

Tucker

On pages 14-15, Appellant argues Miller fails to teach these elements. The rejections relying upon Tucker have been withdrawn.

B. Claims 35-43: Neither of the cited references teaches parsing the received multi-image file to identify one or more images specified by the second codes.

On pages 15-16, Appellant argues Wan fails to teach parsing the multi-image file to identify the one or more images specified by the second codes.

Examiner disagrees.

The “second code” specifies a first subset of images in the multi-image file for display. In Wan, a fragment identifier in figure 13 identifies which image to display. Thus, Wan discloses ***parsing the multi-image file to identify the one or more images specified by the second codes.*** See figure 13, column 2, lines 39-67, column

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17, lines 25-30 and column 18, lines 1-20 where a fragment identifier specifies which image to display such as "BeforeLaunch" image or a "Launching" image.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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